

REMARKS

Rejection to Abstract

Applicant herein amends the Abstract to comply with the current guidelines relating to Abstracts. Note that Applicant still intends the original abstract to be considered part of the disclosure of the present application for the purposes of 35 U.S.C. § 112.

Priority

The Patent Office has disputed the priority claim of the present application. The owner of the present application has had a convoluted history over the past few years. Prior to December 6, 1999, the owner was incorporated under the name Gilbarco Inc. On December 6, 1999, the owner changed its name to Marconi Commerce Systems Inc. (see reel 011687, frame 0678). However, Marconi Commerce Systems Inc. was recently purchased by Danaher Corporation and has changed its name back to Gilbarco Inc. This name change has not yet been recorded, and does not yet enter into the history of the present application. As the parent application was filed September 16, 1998, the original assignment was executed to Gilbarco Inc. As many of the sister cases from the first provisional application issued after the original name change, the various documents have accrued different assignees on their face. However, the entity behind these names is the same.

The Patent Office is correct that the original provisional application 60/060,066 from which the present application claims priority does not list Amy Hetz Wilson as an inventor and such was not identified to the Patent Office until the filing of the parent case. However, the provisional application's disclosure and the disclosure of the present application are identical. Applicant includes a declaration from Ms. Wilson indicating that the subject matter of the present application arises from the portions of the provisional which she in fact did invent and were derived from her work for the assignee. Ms. Wilson's name was inadvertently left off of the inventorship of the provisional application 60/060,066 at the time of its filing. Amy Hetz Wilson is indeed an inventor on provisional application 60/060,066 from which the present application claims priority.

Rejection Under 35 U.S.C. § 102(e) - Terranova

The Patent Office rejected claims 4, 6, 10-14, 26-28, 39, and 44-46 under 35 U.S.C. § 102(e) as being anticipated by Terranova ('871). The Terranova patent is U.S. Patent No. 6,098,879 and was inadvertently labeled as the '871 instead of the '879 patent by the Patent Office.

The Terranova '879 patent was based on provisional patent application number 60/060,066. The present application also claims priority to provisional patent application number 60/060,066. Therefore, the Terranova '879 patent is not 35 U.S.C. § 102(e) art since the Terranova '871 patent does not have an earlier priority filing date than the present application.

Therefore, since (1) Amy H. Wilson is an inventor of subject matter contained in provisional patent application 60/060,066; (2) the specifications between the provisional patent 60/060,066 and the present application are the same; and (3) the Terranova '879 patent relies on the same provisional patent application 60/060,066 as the present invention for priority, the present rejection under 35 U.S.C. § 102(e) cannot be maintained.


Further Actions To Be Taken By Applicant

In order to establish that the present application can properly claim priority to provisional patent application 60/060,066, Applicant is concurrently filing as a separate document a Request to Correct Inventorship under 37 C.F.R. §1.48(d). Applicant expects this Request to be granted, thereby confirming removal of the Terranova reference from the pool of available prior art. However, to help Applicant, Applicant is concurrently filing a Petition to Suspend Action in the present case until the Request to Correct Inventorship can be resolved.

Respectfully submitted,

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